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V/B

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/191,647 11/13/98 GOODMAN

C B98-031-3

EXAMINER

HM12/0818

RICHARD ARON OSMAN  
SCIENCE & TECHNOLOGY LAW GROUP  
75 DENISE DRIVE  
HILLSBOROUGH CA 94010

MCKELVEY, T

ART UNIT

PAPER NUMBER

1636

7

DATE MAILED:

08/18/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/191,647**

Applicant(s)

**Goodman et al.**

Examiner  
**Terry A. McKelvey**

Group Art Unit  
**1636**



☒ Responsive to communication(s) filed on 5/20/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 8-28 is/are pending in the application.

Of the above, claim(s) 20-28 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 8-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. §§ 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. § 1.821(d). The application refers to sequences without the use of the correct identifier.

For example, page 3 of the amendment filed 4/12/99 the application sets forth sequences without sequence identifiers.

Applicants should carefully review the specification to identify and properly label each sequence that is referred to within the specification, including drawings. Sequences in drawings can be identified with a SEQ ID NO: in the Brief Description of the Drawings for the figure or be present in the figure itself. If one or more sequences are referred to in the specification that are not present in the Sequence Listing, then a new Sequence Listing, a new CRF diskette containing the Sequence Listing and a new statement that the two are the same and includes no new matter must be submitted in order to fully comply with the Sequence Rules.

Applicants are required to comply with all of the requirements of 37 C.F.R. §§ 1.821 through 1.825. Any response

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to this Office Action which fails to meet all of these requirements will be considered non-responsive. The nature of the noncompliance with the requirements of 37 C.F.R. §§ 1.821 through 1.825 did not preclude the continued examination of the application on the merits, the results of which are communicated below.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 8-19, drawn to isolated polypeptide, classified in class 530, subclass 300+.
- II. Claims 20-28, drawn to method of identifying agents which modulate Robo/Robo ligand interaction, classified in class 435, subclass 7.8.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be

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used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, regulation of cell function and morphology, as suggested in the specification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In an amendment filed 5/20/99, a provisional election was made without traverse by Richard Osman to prosecute the invention of Group I, claims 8-19. Claims 20-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35

U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

In the instant case, the paragraph setting forth priority is misplaced, and the priority is improperly claimed. The correct way of claiming priority is: "This application claims the benefit of U.S. Provisional Application No: ...".

***Specification***

The disclosure is objected to because of the following informalities: the tables in the application are not included as a part of the specification, with page numbering consistent with the specification, as required.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 8, etc, the reference to Table 1 and Table 2 unboxed residues renders the claims vague and indefinite because the renumbering of the tables results in Tables 1 and 2 not being the tables apparently intended by the applicant. It appears that the applicant intends to mean Tables 3 and 4.

With regard to claims 8, etc, the use of "comprising at least one of ... and ..." renders the claims vague and indefinite because the applicant is attempting to set forth a Markush group and is using unclear language. Amending the claims to the proper format would be remedial: "... comprising at least one sequence selected from the group consisting of ... and ...". The same problem occurs with "at least one of Table 1 and Table 2".

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et al.

Wilson et al teach the isolated amino acid sequence of F40E10.4 protein which comprises over 16 contiguous amino acids of SEQ ID NO:9. See the attached sequence comparison.

***Double Patenting***

Claims 17-19 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 8 and 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).



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Claims 17-19 are drawn to the polypeptides having the same sequences as those in claims 8 and 12, but with the difference that the polypeptides are made by recombinant nucleic acid expression. There is no evidence of record that the means of producing the polypeptides of the same sequence results in a different polypeptide from those polypeptides not made in that fashion and thus it appears that the applicant is claiming duplicate subject matter.

#### **Conclusion**

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

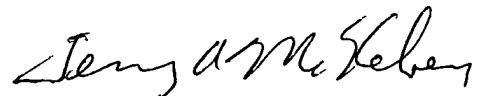
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry A.

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McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 6:30 AM to about 5:00 PM. A phone message left at this number will be responded to as soon as possible (usually no later than 24 hours after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**Terry A. McKelvey, Ph.D.**  
**Primary Examiner**  
**Art Unit 1636**

August 16, 1999